

Remarks
Reconsideration of Restriction under 37 C.F.R. 1.143

In the Office Action, the Examiner noted that claims 1-18 are currently pending in the instant application and said claims are subject to restriction. In particular, the Examiner alleges that "unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper" (pursuant to Rule 13, PCT).

The Examiner alleges that the claims "lack unity of invention under PCT rule 13.1 and 13.2 since, under 37 C.F.R. 1.475(a) the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art." More specifically the Examiner alleges that "The technical feature of the instant claim(s) is the benzimidazole group, which does not define a contribution over the prior art (as can be seen by US Patent No. 6,393,125, which discloses the compound, 4-fluorobenzenesulfonic acid-1-[(methoxycarbonyl)amino]-1H-benzimidazol-5-yl ester, CAS RN 90509-02-7, which corresponds to applicants formula (I) wherein R1 is aryl [halogen], A is aminophenyl [phenyl] and R2 is ester)." Applicants believe the Examiner intended to define R1 and A as noted in brackets in the preceding sentence.

The Examiner further alleges that "due to the numerous and widely divergent variables in the compound of formula (I), for example R₁, R₂, A, etc., a precise listing of inventive groups cannot be made." The Examiner provided exemplary groups I-IV, as summarized in the following table, without classifying the individual groups.

Group	Invention	Class/subclass
I	Claims 1-17 drawn to products of formula (I) wherein R1 contains a cyclopentyl group as shown in claim 7, page 146, line 24, A is an aminophenyl group, and R2 is a carbamate.	
II	Claims 1-17 drawn to products of formula (I) wherein R1 contains a morpholine group as shown in claim 11, page 151, line 15, A is an aminophenyl group and R2 is an ester.	
III	Claims 1-17 drawn to products of formula (I) wherein R1 contains a piperidine group as shown in claim 11, page 151, line 17, A is an aminophenyl group and R2 is an ester.	
IV	Claim 18 is drawn to a method of treating cancer by administering to a subject in need of treatment a compound of formula (I) according to claim 1.	

The Examiner further alleges that "this list is not exhaustive as it would be impossible under the time constraints due to the sheer volume of subject matter instantly claimed." Furthermore, the Examiner indicates that "applicant may choose to elect a single invention (a

product or a method of use of said product) by identifying another specific embodiment, i.e. another value for R₁ and R₂, not listed in the exemplary groups of the invention and examiner will endeavor to group same."

Applicants considered the Examiner's remarks and exemplary Groups I-IV. For reasons unclear to Applicants, the Examiner defined R₁, R₂ and A differently in one or more exemplary Groups I-III versus the definitions of R₁, R₂ and A that appear in the specification. However, in order to be fully responsive to the instant Office Action as noted above, Applicants have elected to prosecute the invention of Group I, but respectfully request that the Examiner reconsider and redefine the groups R₁, R₂ and A as R₁ is NH-cycloalkyl, A is phenyl and R₂ is -CO-alkoxy wherein these definitions are consistent with the specification and claims.

Furthermore, Applicants respectfully traverse that the instant restriction requirement as imposed by the Examiner is improper based on the following grounds:

1. MPEP 803 mandates that there must be a serious burden on the Examiner as one of two criteria for restriction between patentably distinct inventions. A *prima facie* showing of a serious burden on the Examiner is made by the Examiner showing by appropriate explanation of separate classification, or separate status in the art, or a different field of search. The Examiner alleges that an undue burden would be imposed on the Examiner to examine the instant application unrestricted. However, the Examiner did not provide classifications for the inventions of Groups I-IV; thus, it is unclear to applicants whether the inventions of Groups I-IV would be classified the same or differently. Furthermore, the Examiner did not provide explanation as to why the R₁, R₂ and A groups selected for Groups I-III should have separate status in the art or require a different field of search. Thus, the Examiner has not established a *prima facie* showing that an undue burden would be placed on the Examiner or Office resources. Applicants also respectfully refer the Examiner to MPEP § 803 where it states that "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions."
2. Applicants respectfully bring to the Examiner's attention that there was no lack of unity of invention imposed on the corresponding PCT Application No. PCT/EP02/11353.

3. Applicants maintain that product and process of using claims should be rejoined pursuant to MPEP 821.04.
4. Finally, the instant restriction requirement imposes both undue expenses and discourages Applicants by requiring Applicants to prosecute and maintain a plurality of patents, which is against the constitutional intent to promote the progress of science and technology and thus against the public policy.

Applicants respectfully submit the following comments pertaining to specific issues raised in items 1-4 above.

First applicants respectfully submit that the search of all claims 1-18 should not impose an undue burden on the Examiner. Applicants respectfully draw attention to the Table shown above, which lists the exemplary Groups I-IV of the invention. Groups I-III and Group IV are related as product and process of use. Applicants respectfully submit that these inventions are in the same or similar classification and should not impose any undue burden on the Examiner in searching Groups I-IV together. Even more importantly, when the Examiner is searching in one class, that itself may facilitate the search of other invention groups. That is, invention Groups I-III can be searched together, and while searching these invention groups it is highly likely that references pertaining to invention Group IV will be found. Accordingly, Applicants respectfully request that all of the inventions be rejoined and examined together.

Secondly, Applicants respectfully submit that the instant invention is a national stage entry of international application No. PCT/EP02/11353, for which an international preliminary examination report (IPER) has been established. A copy of the IPER is enclosed herewith for the Examiner's review. Claims 1-18 in the instant application are modeled after claims 1-9 in the international application (as provided by amended claim sheets attached to the IPER) and have been presented more suitably in the US format. Applicants respectfully draw attention to section 3, item IV, on the second page of the IPER wherein the box pertaining to the absence of unity of invention is not checked and thus unity of invention is not an issue based on the international preliminary examination. Therefore, Applicants respectfully request that similar standards as used in the international examination be used in the instant application, and that imposition of the instant restriction requirement be withdrawn.

Third, Applicants submit that product claims 1-17 and the corresponding use claim 18 should be rejoined pursuant to MPEP 821.04 that reads:

"Where the application as originally filed discloses the product and the process for making and/or *using the product*, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the process of making and/or *using the patentable product by way of amendment* pursuant to 37 CFR 1.121" (emphasis added).

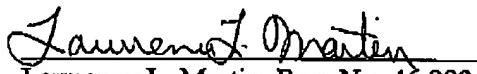
Finally, Applicants submit that the instant restriction imposes both undue expenses and resource allocation requirements on Applicants, since Applicants would have to prosecute and maintain a plurality of patents. Applicants are thus discouraged from obtaining and maintaining full patent protection for their invention, which is against the constitutional intent to promote the progress of science and technology, and thus against the public policy. For these reasons and the reasons advanced above, Applicants respectfully request the Examiner to reconsider and withdraw the instant restriction requirement, and to rejoin the claims of Groups I-IV.

In the event the Examiner wishes to contact the undersigned regarding any matter, please call (collect if necessary) the telephone number listed below.

Applicants further affirm their right to file one or more divisional applications with respect to any of the non-elected subject matter.

Applicants believe there are no fees due for this response. However, if the Examiner deems that fees are due, please charge these fees to Deposit Account No. 18-1982 for Aventis Pharmaceuticals Inc., Bridgewater, NJ. Please credit any overpayment to Deposit Account No. 18-1982.

Respectfully submitted,



Lawrence L. Martin, Reg. No. 46,902
Attorney/Agent for Applicant

Aventis Pharmaceuticals Inc.
Patent Department
Route #202-206 / P.O. Box 6800
Bridgewater, NJ 08807-0800
Telephone (908) 231-4803
Telefax (908) 231-2626
Aventis Docket No. ST01027 US CNT